



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,502	04/12/2004	Chunlin Tao	067456-5036US01	3274
67374 7590 11/28/2007 MORGAN, LEWIS & BOCKIUS, LLP ONE MARKET SPEAR STREET TOWER SAN FRANCISCO, CA 94105			EXAMINER GROSS, CHRISTOPHER M	
			ART UNIT 1639	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,502	Applicant(s) TAO ET AL.	
	Examiner Christopher M. Gross	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892). | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Responsive to communications entered 9/10/2007. Claims 1-14 are pending. Claims 1-14 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120 is again acknowledged: this application is a CON of 09/847,113 05/01/2001 (now PAT 6,753,143) which claims benefit of 60/201,026 05/01/2000 and is a CIP of 09/626,096 07/26/2000.

Withdrawn Objection(s) and/or Rejection(s)

The rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is hereby withdrawn in view of applicant's amendments to the claims.

The rejection of claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bauer (US Patent 6096497 – IDS entry 10/13/2005) is hereby withdrawn in view of Applicant's persuasive arguments.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks et al (US Patent 6,203,758).

Response to Arguments

Applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

Specifically, applicant argues see p 9 fifth paragraph (9/10/2007), Marks et al do not teach an asymmetric monolayer forming species (MFS) that is not "directly attached" to the electroconduit species (AG). In this regard, it is noted that the asymmetric monolayer species used in claim 1 is drawn to "contacting [the] metallic surface with an asymmetric monolayer forming species *having* the formula:". The term 'having' is interpreted as open to other structures, so long as the core MFS-A-A-AG core is present, including for instance, the cyclic disulfide shown in figure 5C according to Marks et al.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., MFS is not "directly attached" to AG) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues, see p 10 (9/10/2007) that figures 2-3 of Marks et al are schematics which illustrate chemical groups in an abstract manner only, thus insulator comprising from about 7 to 20 carbons is not explicitly taught by Marks et al. However, applicant's attention is again respectfully invited to figure 5C, which shows an alkyl chain with 5 carbons, which is taken as in the range of from about 7 to 20 carbon atoms of claim 8.

Applicant argues, see p 11 (9/10/2007), that Marks et al do not teach attachment of a binding ligand *first* followed by immobilization on the metallic support. In this regard, applicant's attention is respectfully invited to figure 1 and the sentence bridging columns 12 and 13, where Marks discuss the array is prepared on a series of electrodes which are derivatized one by one with various "binding entites" such as shown in figure 5c at each location. Through this process, M-A-MFS-binding ligand (M=metal surface) becomes contacted with a metal surface, meeting the limitations of claim 2.

Additionally, the court has held that it is improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) . Here, the language of the method claims, do not impose directly or implicitly a particular order, reciting open language of a method *comprising...*with a...species *having*.

To the best the Examiner can understand, applicant is arguing that claim 2 is drawn to pre-forming a A-MFS-capture binding ligand.

However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pre-forming a A-MFS-capture binding ligand) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639


MARK L. SHIBUYA
PRIMARY EXAMINER